



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Inventor(s) : Andrew M. Proehl
Filed : 1/29/2004
Serial No. : 10/767,473
Confirmation No. : 3618
Group Art Unit : 2174
Examiner : Nguyen, Le V.
Docket Number : 50N3127.01
Title : USER INTERFACE HAVING A CROSS ARRANGEMENT

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is, on the date shown below, being deposited with the U.S. Postal Service as first class mail with sufficient postage in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Applicant, Assignee or Reg. Representative: JERRY A. MILLER Reg. No. 30,779

Signature: /Jerry A. Miller 30779/ Date: 8/6/2009

APPEAL BRIEF

This appeal brief is submitted in **triplicate** in response to the Final Office Action dated March 19, 2009. Reconsideration and allowance of all claims at issue are respectfully requested.

The fee for this brief is being paid by ☒ credit card payment form ☐ check ☐ deducted from deposit account number 501267. The Commissioner is authorized to deduct any underpayment or credit any overpayment to deposit account number 501267.

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST.....	3
2. RELATED APPEALS AND INTERFERENCES.....	4
3. STATUS OF CLAIMS.....	5
4. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION.....	6
5. SUMMARY OF CLAIMED SUBJECT MATTER.....	7
6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	9
7. ARGUMENTS.....	10
8. CLAIMS APPENDIX.....	34
9. EVIDENCE APPENDIX.....	36
10. RELATED PROCEEDINGS APPENDIX.....	37

1. REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee(s) of record of this application - Sony Corporation and Sony Electronics, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

3. STATUS OF CLAIMS

Claim 104 was rejected with the rejection made final on March 19, 2009.

Claims 1-86 were previously cancelled without prejudice.

Claims 87-103 were withdrawn from consideration.

Claim 104 is pending and the subject of this Appeal.

4. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

All amendments have been entered to the best of Appellant's knowledge.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The following summary is supplied in compliance with the requirements of the appeal rules. The undersigned wishes to note that this summary is provided merely as an aid to the Board in rapidly understanding the invention and the issues relating to this appeal and does not supersede what the claims actually state (69 Fed. Reg. 155 (Ayg, 2004)). As such, this summary should not be construed to limit the invention in any way.

Independent claim 104 recites, in an audio/visual (AV) system (Specification, page 1, lines 14-15), a method for navigation (Specification, page 2, line 21) of menu options available to a user of the AV system (Specification, page 2, line 21), comprising: entering a graphical user interface (GUI) (Specification, page 10, lines 16-17) in a menu system that is displayed on a display (Specification, page 9, lines 23-24);

generating a signal for displaying a first navigable list of menu options on the display (Specification, page 4, lines 24-25; Figure 9, list element 230), the first navigable list of menu options (Figure 9, list element 230) having a plurality of fields (Specification, page 9, line 1; Figure 3, elements 65; Figure 9, elements, 216, 232, 238, 240, 242) arranged in a first linear configuration (Figure 3, element 64, element 68; Figure 9, list element 230) that overlays AV content currently playing on the display (Figure 9, Figure 10, and Figure 11) with one of the menu options shown (Figure 9, elements 236) at a location of the display that is highlighted (Specification, page 14, lines 18-19; Figure 9, elements 232 and 236);

responsive to a navigation command (Specification, page 14, lines 13-16) from a remote controller (Figure 1A, element 10), moving the first navigable list of menu options (Figure 9, list element 234) of the GUI (Specification, page 14, lines 13-16) to cause another field of the plurality of fields to move to the location that is highlighted (Figure 9, element 204), and thus highlight the another field (Figure 9, element 204) while continuing to display the AV content currently playing on the display (Figure 9);

responsive to a navigation command (Specification, page 14, lines 27-29) from the remote controller (Figure 1A, element 10), generating a signal for displaying a second navigable list of menu options (Figure 10, elements 210-222) associated with the highlighted field (Figure 10, element 216), the second navigable list of menu options (Figure 10, elements of horizontal row beginning with element 216) arranged in a second linearly configured set of fields (Figure

10, elements of horizontal row beginning with element 216) which intersect the first linear configuration of fields of the first navigable list of menu options (Figure 10, element 216) at the highlighted location (Figure 10, element 216) and overlaying the AV content currently playing on the display (Figure 10);

navigating to a menu option of the second navigable list of menu options (Figure 11, list element 246) in response to a navigation command (Specification, page 15, lines 5-7);

selecting the menu option (Figure 11, element 238) of the second navigable list (Figure 11, list element 246) in response to a selection command from the remote controller (Specification, page 15, lines 12-14), wherein the AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content (Figure 11);

upon selection of the menu option (Figure 11, element 238) from the second navigable list (Figure 11, list element 246), ceasing the generating of the signals for displaying the first and second navigable list of menu options so that the first and second navigable list of menu options disappear from the display and taking an action associated with the menu selection (Specification, page 3, lines 7-10); and

wherein the first linear configuration of the first menu is oriented substantially horizontally (Figure 9, list element 230), and the second linear configuration of the second menu is oriented substantially vertically (Figure 9, list element 234).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claim 104 was properly rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,678,891 to Wilcox et al. (hereinafter “Wilcox”) in view of U.S. Patent No. 6,753,928 to Gospel et al. (hereinafter “Gospel”), and further in view of U.S. Patent No. 6,505,348 to Knowles et al. (hereinafter “Knowles”).

7. ARGUMENTS

A. Introduction

The Patent Office has alleged the Wilcox reference to form an obviousness rejection of independent claim 104 in view of elements alleged to be disclosed within the Gospel reference and further in view of elements alleged to be disclosed within the Knowles reference. However, the Patent Office has erred by not showing where all the elements of Appellant's claim 104 are depicted with sufficient particularity in the Wilcox reference in combination with the Gospel and Knowles references to sustain a *prima facie* case of obviousness. Based upon these deficiencies, the allegations of the Patent Office constitute material and clear errors of fact regarding the scope and content of the cited references.

Regarding the failure to show all elements of Appellant's claim 104, specific elements of claim 104 are not taught or suggested by the Wilcox reference, the Gospel reference, or the Knowles reference, or a combination thereof. The claimed invention is directed to, among other things, a second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location. The Patent Office has failed to identify intersection of the claimed second navigable list of menu options arranged in a second linearly configured set of fields with a first linear configuration of fields of the first navigable list of menu options. The Patent Office has further failed to identify intersection of the claimed elements at the claimed highlighted location.

The Patent Office has further admitted that that "Wilcox and Carlson [sic] do not explicitly disclose AV content currently playing on the display that continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content" The cited reference Carlson is not a reference of record in the present application. Further, the Patent Office appears to have disregarded the conditional "unless" within Appellant's claim 104 and has cited the Knowles reference that provides multiple options for tuning to the new channel.

The failure of the Patent Office to identify all of Appellant's claimed subject matter within the cited combination of references constitutes material and clear errors of fact regarding the scope and content of the cited references. Based at least upon the clear errors of fact

regarding the scope and content of the cited references, the allegations of the Patent Office constitute material and clear errors of fact regarding the differences between Appellant's claim language and the disclosure of the cited references. Further, the Patent Office has erred by failing to properly consider Appellant's claim language and has alleged additional material and clear factual errors regarding differences between Appellant's claim language and the disclosure of the cited references.

For example, within the Advisory Action dated May 7, 2009, at page 2, the Patent Office alleges that one of Appellant's arguments in the Response filed April 16, 2009, is improper. However, Appellant believes that such an allegation is improper and is believed to indicate a misunderstanding of Appellant's claim language by the Patent Office, suggestive of a material and clear error on the part of the Patent Office regarding the scope and content of Appellant's claim 104.

The Wilcox reference further teaches away from Appellant's claimed subject matter. The Wilcox reference additionally cannot be modified and combined with the cited references without rendering the Wilcox reference unsatisfactory for its intended purpose and without changing at least one of its principles of operation. The Knowles reference also teaches away from Appellant's claimed subject matter.

Furthermore, based at least upon the many gaps between the actual disclosure of the cited references and Appellant's claims, the Patent Office has erred by engaging in impermissible hindsight reconstruction and has not articulated any reasoning as to why a person of ordinary skill in the art would find the claims obvious in view of the missing elements discussed above.

The Patent Office has erred by ignoring certain portions of Appellant's claim language, has failed to properly analyze the subject matter of the cited references, and has failed to properly determine the differences between Appellant's claimed subject matter and the references as cited. For these and other reasons, discussed in more detail below, the Patent Office's allegations of fact are clearly erroneous.

Further, the Patent Office's interpretation of the Wilcox reference in combination with the Gospel and Knowles references is at least clearly erroneous and is not reasonable to someone skilled in the art. The clearly erroneous interpretations of the cited references further shows that the Patent Office has failed to properly consider the language of Appellant's claims, has failed to

properly consider the actual disclosure of the cited references, and has failed to properly consider the differences between the claims and the cited references – all clear errors of fact.

For at least these reasons, the Patent Office’s legal conclusion of obviousness is also deficient as at least failing to properly consider the actual scope and contents of the cited references, and for failing to properly consider the differences between the claimed subject matter and the actual disclosure of the cited references. Accordingly, the Patent Office has failed to establish a *prima facie* case of obviousness against claim 104 for at least these additional reasons.

In summary, since the Patent Office has not shown where each and every element is taught or suggested in the combined references, obviousness has not been established. The Patent Office’s interpretation of the Wilcox reference in combination with the Gospel and Knowles references is at least clearly erroneous and is not reasonable to someone skilled in the art. The Wilcox reference and the Knowles reference teach away from Appellant’s claimed subject matter. The Wilcox reference further cannot be modified and combined with the cited references without rendering the Wilcox reference unsatisfactory for its intended purpose and without changing at least one of its principles of operation. The Patent Office appears to have used impermissible hindsight recreation to combine embodiments and improperly fill gaps in the cited references to deprecate Appellant’s claimed subject matter.

Accordingly, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

B. Summary of the References

1. U.S. Patent No. 6,678,891 to Wilcox et al. (hereinafter “Wilcox”)

The Wilcox reference discloses a navigation user interface for television that appears to be based upon a concept termed “nodes.” Nodes are disclosed as “any element, such as a menu item, or screen that may be displayed” (Wilcox, column 15, lines 28 and 29). Nodes have properties, such as focus, and the node having focus is the “one the viewer 12 is currently able to manipulate using the input device 13.” (Wilcox, column 15, lines 43-45). A “node that does not have focus cannot be manipulated or selected” (Wilcox, column 15, lines 45-47).

The Wilcox reference discloses that one type of node is a category item 112 that includes a list of category item icon nodes 120. (Wilcox, Figures 15, 16, and 18, as cited by the Patent

Office; See also, Figures 5, 6, and 7). The Wilcox reference discloses that another type of node is a menu item 114 that includes a list of menu item icon nodes 122. (Wilcox, Figures 15, 16, and 18, as cited by the Patent Office; See also, Figures 5, 6, and 7). Further, the category item icon nodes 120 and the menu item icon nodes 122 may be placed in various locations on a television display device. (Wilcox, column 23, lines 15-17).

As such, the Wilcox reference discloses that the category item 112 that includes a list of category item icon nodes 120 is distinct from the menu item 114 that includes a list of menu item icon nodes 122.

Stationary visual cues 124 inform the viewer that the category item icon nodes 120 may be scrolled left and right. (Wilcox, Figures 5, 6; and col. 20, lines 30-32). Stationary visual cues 130 inform the viewer that the menu item icon nodes 122 may be scrolled up and down. (Wilcox, Figures 5, 6; and col. 22, lines 2-4).

As such, the Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 are separated by “stationary” visual cues, 124 and 130, respectively.

The Patent Office alleges within the Final Office Action dated March 19, 2009, and within the Advisory Action dated May 7, 2009, that the category item icon nodes 120 and the menu item icon nodes 122 meet/intersect. (Final Office Action dated March 19, 2009, pages 3-4, and Advisory Action dated May 7, 2009, page 2). However, in contrast to the allegations of the Patent Office, Appellant finds no teaching or suggestion of the category item icon nodes 120 and the menu item icon nodes 122 meeting or intersecting.

The Wilcox reference discloses a focus-box 118 and a separate and distinct menu focus box 128 that respectively let the viewer know which of the respective items from the respective lists are selected. (Wilcox, Figure 6; and column 19, lines 40-42, and column 21, lines 28-30). However, Appellant respectfully submits that multiple distinct focus boxes do not teach or suggest a single highlighted location of a display, as claimed. Further, Appellant finds no teaching or suggestion of the focus-box 118 and a separate and distinct menu focus box 128 intersecting.

It is further respectfully submitted that the Wilcox reference appears to teach away from the category item icon nodes 120 and the menu item icon nodes 122 meeting or intersecting at least based upon the disclosure that the respective nodes are separated within the respective category item 112 and the menu item 114, and that these nodes have “stationary” visual cues 124

and 130, respectively, at their ends. As such, the Wilcox reference obviates the need to allow multiple lists to intersect. Further, because the Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 may be placed in various locations on a television display device, modification of the Wilcox reference to force the respective nodes to intersect would render the Wilcox reference unsatisfactory for its intended purpose and would change a principle of operation of the Wilcox reference.

Accordingly, the Wilcox reference at least does not teach or suggest a “second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location,” as claimed.

2. U.S. Patent No. 6,753,928 to Gospel et al. (hereinafter “Gospel”)

Appellant indicated in the previous Response filed April 16, 2009, that the Final Office Action dated March 19, 2009, appears to contain an error at page 4, lines 11 and 20, where “Carlson” is believed to be erroneously called out instead of “Wilcox” and “Gospel” respectively. The following description is based upon the belief that the Wilcox and Gospel references were the intended references.

The Gospel reference is directed to an approach to providing feedback during programming of a television. (Gospel, Title). An auxiliary image is included in a television display to display simultaneously a video/audio signal of an input source or channel being mapped and an on-screen display (OSD) menu during a mapping process to provide feedback to a user that the input source is correctly connected to the television. (Gospel, column 2, lines 45-50). As such, the Gospel reference is not believed to be particularly relevant to Appellant’s claimed subject matter.

3. U.S. Patent No. 6,505,348 to Knowles et al. (hereinafter “Knowles”)

The Knowles reference is directed to a multiple interactive program guide. (Knowles, Title). Different television programming and different interactive programming guides (IPGs) are provided to several different users. (Knowles, Abstract). A single set-top-box provides programming and scheduling for multiple television sets. *Id.* The respective IPGs may add to or modify other IPGs. *Id.* Viewing rights of users may be influenced by other users. *Id.* Competing

and conflicting resources, such as video cassette recorder (VCR) scheduling of recordings, may be brought to the attention of users. *Id.*

The Patent Office alleges that the Knowles reference discloses the claimed “AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content.” (Final Office Action dated March 19, 2009, page 5). However, Appellant has reviewed the cited portion of the Knowles reference and finds that the actual disclosure of the cited portion requires either a timeout period or requires the user to select a SELECT key on a remote device to perform the disclosed actions. For example, the Knowles reference discloses that “[w]hen the pop-up times out (in two seconds) or the user presses SELECT, the IPG closes the guide and tunes to the new channel.” (Knowles, column 15, lines 13-15, as cited by the Patent Office).

As such, the Knowles reference requires either a timeout to expire or requires a user interaction with a specific button (e.g., the SELECT button) to tune to a new channel. Appellant respectfully submits that an “either/or” combination of functionality within the cited portion of the Knowles reference does not teach or suggest at least Appellant’s claimed “unless” conditional. Accordingly, in contrast to the allegations of the Patent Office, the cited portion of the Knowles does not appear to teach or suggest the claimed “AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content.”

The Knowles reference further appears to teach away from Appellant’s claimed subject matter by requiring additional actions to occur prior to tuning to a new channel. By the Knowles reference requiring a delay for the timeout to expire or the user to further interact and depress the specific SELECT key on a remote device for a new channel to actually be tuned, the Knowles reference teaches away from Appellant’s claimed subject matter.

C. The Standards for Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in

the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as being a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998) (internal citations omitted). The numbered elements are also known and referred to herein as the *Graham* factors.

What a reference teaches is a question of fact reviewed under the clearly erroneous standard. *In Re Chu*, 66 F.3d 292, 298 (Fed. Cir. 1995) (citing *In re Beattie*, 974 F.2d 1309, 1311, 24 U.S.P.Q.2d (BNA) 1040, 1041 (Fed. Cir. 1992)).

The burden is on the Patent Office to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). “To reach a proper conclusion under § 103, the decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made.” *Id.* at 1073 (quoting *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987) (paraphrase in *Fine*’s original text)). Furthermore, “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to pieced [sic] together the teachings of the prior art so that the claimed invention is rendered obvious ‘one cannot use a hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’ ” *In Re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 and quoting *In re Fine*, 837 F.2d at 1075.

For a *prima facie* case of obviousness, the combination must teach or fairly suggest all the claim elements. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. When determining whether the references or combination of references teaches an element, the Patent Office is entitled to interpret the claim elements broadly. However, this interpretation is limited in several respects. First, the interpretation is made in light of the specification. Further, the interpretation must be reasonable to someone skilled in the art. MPEP § 2111.

For the Patent Office to combine references in an obviousness rejection, the Patent Office must first establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. MPEP § 2143.03. This is fundamental to an analysis under the factual inquiries required by *Graham v. John Deere*, 383 U.S. 1 (Supreme Court, 1966), as a part of identification of the scope and content of the prior art. “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 127 S. Ct. 1727 at 1741, 82 USPQ2d at 1396 (U.S. 2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The Patent Office must provide articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the prior art. (See *In re Kahn*, 441 F.3d 977, 988 (CAFC, 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue.

Secondary considerations of non-obviousness include, among other things, “commercial success, long felt but unresolved needs, failure of others, etc. . . .” *Graham v. John Deere*, 383 U.S. 1, at 17-18 (Supreme Court, 1966). As such, the Supreme Court has made clear that there are additional secondary considerations that may be useful to determining non-obviousness of claims. “[S]econdary considerations of nonobviousness as commercial success, long felt but unsolved needs, failures of others, and copying are considered in determining obviousness.” (*Para-Ordnance Mfg., Inc. v. SGS Importers Intern., Inc.*, 73 F.3d 1085, at 1088, citing *Graham v. John Deere*, 383 U.S. 1 (Supreme Court, 1966)). Accordingly, the Supreme Court and the Court of Appeals for the Federal Circuit have explicitly endorsed the proposition that additional secondary considerations are available to show non-obviousness.

For example, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (MPEP § 2143.01, V, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01, VI, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Furthermore, “[a] rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.” (MPEP § 2143.02, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950), emphasis added).

Additionally, “[w]here the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another.” (MPEP § 2143.01, II, citing *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)). The Patent Office may not ignore portions of the reference which teach away from the combination. *Baxter Int’l Inc. v. McGaw Inc.*, 149 F.3d 1321, 1328 (Fed. Cir. 1998). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. (MPEP § 2141.02, I, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), emphasis in original). “A reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (MPEP § 2141.02 VI, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), emphasis in original).

However, if a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[i]f the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

D. Claim 104 Is Not Obvious and Was Not Properly Rejected Under 35 U.S.C. § 103(a) as Being Unpatentable Over Wilcox in View of Gospel and Further in View of Knowles

Claim 104 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,678,891 to Wilcox et al. (hereinafter “Wilcox”) in view of U.S. Patent No. 6,753,928 to Gospel et al. (hereinafter “Gospel”), further in view of U.S. Patent No. 6,505,348 to Knowles et al. (hereinafter “Knowles”). For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element can be found in the combination of references. MPEP § 2143.03.

The Patent Office has erred by not showing where each and every element is taught or suggested in the combined references. Accordingly, obviousness has not been established. Additionally, at least because the Wilcox reference discloses that the category item icon nodes and the menu item icon nodes may be placed in various locations on a television display device, modification of the Wilcox reference to force the respective nodes to intersect would render the Wilcox reference unsatisfactory for its intended purpose and would change a principle of operation of the Wilcox reference. Further, the Wilcox reference and the Knowles reference each independently teach away from Appellant’s claimed subject matter by disclosure of stationary visual cues that delimit and establish boundaries for the respective nodes, and by disclosure of requiring additional actions to occur prior to tuning to a new channel, respectively. Based upon the multiple deficiencies in the present rejections, the Patent Office appears to have used impermissible hindsight recreation to combine embodiments to deprecate Appellant’s claimed subject matter.

1. Multiple Elements of Claim 104 are Missing from Wilcox in Combination with Gospel and Knowles

The first reason that the obviousness rejection is deficient is that the Patent Office has erred by failing to properly show where all elements of the claims are shown. Appellant addresses elements that are missing from the cited references below in an order convenient for discussion.

a. Wilcox in Combination with Gospel and Knowles Does Not Teach or Suggest a Second Navigable List of Menu Options Arranged in a Second Linear Configured Set of Fields which Intersect the First Linear Configuration of Field of the First Navigable List of Menu Options at the Highlighted Location, as Claimed

Claim 104 recites, among other things, “the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location and overlaying the AV content currently playing on the display” (emphasis added). The Patent Office alleges that this claimed subject matter is disclosed within the Wilcox reference within Figures 3, 4 and 7. (Final Office Action dated March 19, 2009, page 3). The Patent Office then alleges that the “second navigable list of menu options 114 of second linear configuration having fields 122 and intersects the first linear configuration wherein second navigable list is associated with the highlighted 110” (*Id.* at pages 3 and 4, emphasis added).

As an initial observation, the allegations of the Patent Office fail to properly identify multiple elements within the Wilcox reference. Appellant respectfully submits that the Patent Office cannot form a proper *prima facie* case of obviousness without proper consideration of the actual disclosure of the cited references. To provide a few examples of improper identification of elements, the Patent Office cites “fields 122” and “fields 120”, when in fact, element 122 is actually menu item icon nodes 122 and element 120 is actually category item icon nodes 120. Additionally, the Patent Office cites a “highlighted 110” when, in fact, element 110 is actually a screen 110. Further, the Patent Office cites “menu options 114” when, in fact, element 114 is actually menu item 114. (All examples from Final Office Action dated March 19, 2009, pages 3-4). Accordingly, the Final Office Action dated March 19, 2009, is defective on its face for failing to properly identify multiple cited elements within the cited Wilcox reference.

Further regarding the allegations quoted above, there are at least two fundamental flaws Appellant wishes to address within this section. As such, Appellant will address these allegations in two parts below, with the first part addressing defects of the allegation that the second navigable list of menu options 114 of second linear configuration having fields 122 and intersects the first linear configuration. The second part addresses defects of the allegation that the “highlighted 110” discloses Appellant’s claimed highlighted location of intersection.

First, regarding the defects of the allegation that the second navigable list of menu options 114 of second linear configuration having fields 122 and intersects the first linear configuration, Appellant finds that the actual disclosure of the Wilcox reference is different from the allegations of the Patent Office and distinct from Appellant's claimed subject matter. The Wilcox reference actually discloses that each of the category item 112 that includes the category item icon nodes 120 and the menu item 114 that includes the menu item icon nodes 122 have "stationary" visual cues, 124 and 130, respectively, at the ends of the respective nodes. (Wilcox, Figures 5, 6; and col. 20, lines 30-32; col. 22, lines 2-4). At least because the stationary visual cues are not in contact with other nodes with which they are not associated, the respective nodes do not intersect. As can further be seen from Figures 5 and 6, and Figure 7 (as cited by the Patent Office), the category item 112 and the menu item 114, in fact, do not intersect. Appellant further finds no teaching or suggestion of the respective nodes or items intersecting within any of the cited portions of the Wilcox reference.

As such, the allegation by the Patent Office that the menu options 114 intersect with the fields 122 constitutes a material and clear error of fact regarding the actual disclosure of the Wilcox reference. Additionally, as discussed above, these allegations also mischaracterize the actual disclosure of the Wilcox reference by failing to properly identify multiple elements within the Wilcox reference. Accordingly, the material and clear error of fact regarding the actual disclosure of the Wilcox reference further constitutes a clear error of fact regarding the scope and contents of the Wilcox reference. The material and clear error of fact regarding the scope and contents of the Wilcox reference further results in a material and clear error of fact regarding the differences between Appellant's claim 104 and the disclosure of the Wilcox reference.

The Patent Office has not alleged that either of the Gospel reference or the Knowles reference cures these deficiencies of the Wilcox reference. Appellant further respectfully submits that it find no teaching or suggestion of the subject matter as claimed within the cited combination of references.

Therefore, the combination of the Wilcox reference with the Gospel and Knowles references does not teach or suggest a "the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location and overlaying the AV content currently playing on the display" as required by claim 104.

To provide a more comprehensive treatment of the Wilcox reference, Appellant notes that the Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 may be placed in various locations on a television display device. (Wilcox, column 23, lines 15-17). While it may or may not be possible to cause the category item icon nodes 120 and the menu item icon nodes 122 to intersect, Appellant finds no teaching or suggestion of intersection of the respective elements within the Wilcox reference as cited. As such, the allegation of the Patent Office that the respective elements intersect is also not supported by factual evidence regarding placement of the respective nodes at various locations on a screen.

It is further respectfully submitted that any attempt to overlay the respective elements to cause them to intersect would disrupt the viewing of at least one of the respective elements, would render the Wilcox reference unsatisfactory for its intended purpose, and would change a principle of operation of the Wilcox reference. Accordingly, for at least this additional reason, Appellant respectfully submits that it finds no teaching or suggestion within the Wilcox reference of the respective nodes intersecting.

Appellant addresses the observation that the Wilcox reference teaches away from intersection of the respective elements under a separate heading below. Appellant also addresses, under a separate heading below, the observation that modification of the Wilcox reference to force the respective nodes to intersect would render the Wilcox reference unsatisfactory for its intended purpose and would change a principle of operation of the Wilcox reference.

Based at least upon this analysis, the Patent Office has failed to satisfy at least two prongs of the *Graham* test with respect to making a *prima facie* case of obviousness. One, the Patent Office has alleged a material and clear error of fact regarding the scope and contents of the Wilcox reference in combination with the other cited references. Two, the Patent Office has alleged a material and clear error of fact regarding the differences between Appellant's claim 104 and the disclosure of the Wilcox reference in combination with the other cited references.

Second, regarding the defects of the allegation that the "highlighted 110" discloses Appellant's claimed highlighted location of intersection, as an initial observation and in contrast to this allegation by the Patent Office, element 110 of the Wilcox reference is actually a screen 110. (Wilcox, column 15, line 33; Figure 7 as cited by the Patent Office). As such, the screen 110 is in fact not a "highlighted 110" as alleged by the Patent Office. Appellant respectfully

submits that this allegation by the Patent Office appears to have misinterpreted the actual disclosure of the Wilcox reference regarding the screen 110. By characterizing the screen 110 as a “highlighted 110,” the Patent Office has misrepresented the actual disclosure of the Wilcox reference regarding the screen 110.

Further, as discussed above, claim 104 recites, among other things, “the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location and overlaying the AV content currently playing on the display” (emphasis added). As also discussed above, Appellant finds no teaching or suggestion of the respective elements of the Wilcox reference intersecting. Based additionally at least upon the distinction between the allegation of the “highlighted 110” and the actual disclosure of a screen 110, the Patent Office has further not identified Appellant’s claimed highlighted location where the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options within the Wilcox reference as alleged.

Based at least upon these distinctions, the allegation by the Patent Office that the screen 110 discloses the claimed highlighted location of intersection constitutes a material and clear error of fact regarding the actual disclosure of the Wilcox reference. Additionally, as discussed above, these allegations also mischaracterize the actual disclosure of the Wilcox reference by failing to properly identify multiple elements within the Wilcox reference. Accordingly, the material and clear error of fact regarding the actual disclosure of the Wilcox reference further constitutes a clear error of fact regarding the scope and contents of the Wilcox reference and a material and clear error of fact regarding the differences between Appellant’s claim 104 and the disclosure of the Wilcox reference.

Further, the Wilcox reference as cited does not appear to teach or suggest a highlighted location, as claimed. To provide a more comprehensive treatment of the Wilcox reference, Appellant notes that the Wilcox reference discloses a category focus-box 118 and a separate and distinct menu focus box 128 that respectively let the viewer know which of the respective items from the respective lists are selected. (Wilcox, Figure 6; and column 19, lines 40-42, and column 21, lines 28-30). However, Appellant respectfully submits that multiple distinct focus boxes do not teach or suggest a unitary highlighted location of a display at which Appellant’s claimed

second navigable list of menu options arranged in a second linearly configured set of fields intersect the first linear configuration of fields of the first navigable list of menu options. Further, Appellant finds no teaching or suggestion of the category focus-box 118 and the separate and distinct menu focus box 128 intersecting.

Further, disclosure of a category focus-box 118 and a separate and distinct menu focus box 128 that are displayable graphical elements and that are displayed on the screen 110 is believed to be distinct from Appellant's claimed highlighted location where the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options.

Appellant further believes that the allegation by the Patent Office that the screen 110 discloses the claimed highlighted location of intersection shows that the Patent Office has misinterpreted Appellant's claim language. Claim 104 additionally recites, among other things, that the highlighted location is a "location of the display that is highlighted" (emphasis added). As such, by improperly characterizing a screen 110 as a "highlighted 110," the Patent Office appears to have disregarded the language of Appellant's claim 104. This disregard for Appellant's claim language has resulted in a material and clear error of fact regarding the differences between Appellant's claim 104 and the disclosure of the Wilcox reference.

Based at least upon this analysis, the Patent Office has failed to satisfy at least two prongs of the *Graham* test with respect to making a *prima facie* case of obviousness. One, the Patent Office has alleged a material and clear error of fact regarding the scope and contents of the Wilcox reference in combination with the other cited references. Two, the Patent Office has alleged a material and clear error of fact regarding the differences between Appellant's claim 104 and the disclosure of the Wilcox reference in combination with the other cited references.

In summary, the Patent Office has alleged multiple material and clear errors of fact regarding the scope and contents of the Wilcox reference in combination with the other cited references. As such, the Patent Office has also failed to identify multiple elements of Appellant's claim 104 within the Wilcox reference in combination with the other cited references. The Patent Office has further alleged material and clear errors of fact regarding the differences between Appellant's claim 104 and the disclosure of the Wilcox reference in combination with the other cited references. As such, the Patent Office has failed to establish a *prima facie* case of obviousness against claim 104 for at least these reasons, as discussed above.

Accordingly, for at least these reasons the present rejections should be overturned.

b. Wilcox in Combination with Gospel and Knowles Does Not Teach or Suggest that the AV Content Currently Playing on the Display Continues to Play Unless the Menu Option Selected is a Menu Option that Begins Playing a Different Selection of AV Content, as Claimed

Claim 104 additionally recites, among other things, “selecting the menu option of the second navigable list in response to a selection command from the remote controller, wherein the AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content” (emphasis added). The Patent Office admits that “Wilcox and Carlson [sic] do not explicitly disclose AV content currently playing on the display that continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content” (Final Office Action dated March 19, 2009, page 5). It was noted by Appellant in the Response filed April 16, 2009, that the citation to Carlson is believed to be an error. It is believed to be an admission by the Patent Office that Gospel does not disclose this claimed subject matter.

As a preliminary matter, within the Advisory Action dated May 7, 2009, at page 2, the Patent Office alleges that one of Appellant’s arguments in the Response filed April 16, 2009, is improper. The Patent Office alleges that “it is noted that the features . . . (i.e., the AV content to continue to play if a menu option does not select a different selection of AV content) are not recited in the rejected claim(s).” (Advisory Action dated May 7, 2009, page 2). However, as quoted above, claim 104 recites, in relevant part, that “AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content”

Appellant respectfully submits a logical equivalence of the claimed continuing to play unless the menu option selected is a menu option that begins playing a different selection of AV content and AV content to continue to play if a menu option does not select a different selection of AV content. The result is the same in that AV content continues to play unless a menu option selected is a menu option that begins playing a different selection of AV content. As such, the allegation of the Patent Office that a logical equivalent of Appellant’s claim language is not an appropriate argument for Appellant to have made within the prior Response, for purpose of

argument in response to a rejection, signifies a problem on the part of the Patent Office regarding a proper interpretation of Appellant's claim 104. Accordingly, the allegation of the Patent Office is believe to indicate a misunderstanding of Appellant's claim language, suggestive of a material and clear error on the part of the Patent Office regarding the scope and content of Appellant's claim 104.

Additionally, as discussed above under separate heading, the Patent Office has failed to identify Appellant's claimed "second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location and overlaying the AV content currently playing on the display" (emphasis added). Accordingly, for at least this reason, the Patent Office has not identified Appellant's claimed "selecting the menu option" of the claimed "second navigable list" either. Based at least upon these distinctions, the Patent Office has also not identified Appellant's claimed "AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content" within the cited combination of references.

The Patent Office alleges that Appellant's claimed subject matter is disclosed within the Knowles reference within column 15, lines 1-19. (Final Office Action dated March 19, 2009, page 5). However, Appellant has reviewed the cited portion of the Knowles reference and finds that the actual disclosure of the cited portion requires either a timeout period or requires the user to select a SELECT key on a remote device to perform the disclosed actions. For example, the Knowles reference discloses that "[w]hen the pop-up times out (in two seconds) or the user presses SELECT, the IPG closes the guide and tunes to the new channel." (Knowles, column 15, lines 13-15, as cited by the Patent Office).

As such, the Knowles reference requires either a timeout to expire or requires a user interaction with a specific button (e.g., the SELECT button) to tune to a new channel. Appellant respectfully submits that an "either/or" combination of functionality within the cited portion of the Knowles reference does not teach or suggest at least Appellant's claimed "unless" conditional. Accordingly, in contrast to the allegations of the Patent Office, the cited portion of the Knowles does not appear to teach or suggest the claimed "AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content," as claimed.

Based upon this analysis, this allegation of the Patent Office constitutes a material and clear error of fact regarding the actual disclosure of the Knowles reference. Accordingly, the material and clear error of fact regarding the actual disclosure of the Knowles reference further constitutes a clear error of fact regarding the scope and contents of the Knowles reference. The material and clear error of fact regarding the scope and contents of the Knowles reference further results in a material and clear error of fact regarding the differences between Appellant's claim 104 and the disclosure of the Knowles reference.

Therefore, the combination of the Wilcox reference with the Gospel and Knowles references does not teach or suggest a "selecting the menu option of the second navigable list in response to a selection command from the remote controller, wherein the AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content" as required by claim 104.

In summary, the Patent Office has alleged material and clear errors of fact regarding the scope and contents of the Knowles reference in combination with the other cited references. As such, the Patent Office has also failed to identify multiple elements of Appellant's claim 104 within the Knowles reference in combination with the other cited references. The Patent Office has further alleged material and clear errors of fact regarding the differences between Appellant's claim 104 and the disclosure of the Knowles reference in combination with the other cited references. As such, the Patent Office has failed to establish a *prima facie* case of obviousness against claim 104 for at least these reasons, as discussed above.

Accordingly, for at least these additional reasons the present rejections should be overturned.

2. The Disclosure of the Wilcox Reference Relied Upon by the Patent Office Cannot Be Modified and Combined with the Gospel and Knowles References Without Rendering the Wilcox Reference Unsatisfactory for Its Intended Purposes and Without Changing a Principle of Operation of the Wilcox Reference

The second reason that the obviousness rejection is deficient is the Patent Office's allegation of a combination that cannot be modified and combined without rendering the Wilcox

reference unsatisfactory for its intended purpose and without changing at least one of its principles of operation.

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (MPEP § 2143.01, V, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01, VI, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

The Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 may be placed in various locations on a television display device. (Wilcox, column 23, lines 15-17). At least because the Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 may be placed in various locations on a television display device, modification of the Wilcox reference to force the respective nodes to intersect would render the Wilcox reference unsatisfactory for its intended purpose and would change a principle of operation of the Wilcox reference.

It is further respectfully submitted that any attempt to overlay the respective elements to cause them to intersect would disrupt the viewing of at least one of the respective elements, would render the Wilcox reference unsatisfactory for its intended purpose, and would change a principle of operation of the Wilcox reference.

Additionally, the Wilcox reference may not be combined with the Gospel and Knowles references as cited to arrive at Appellant’s claimed subject matter without such a modification. Accordingly, the Wilcox reference cannot be combined with the Gospel and Knowles references without rendering the Wilcox reference unsatisfactory for its intended purpose and changing a principle of operation of the Wilcox reference.

Based upon this analysis, there is no suggestion or motivation to make the proposed modification to the Wilcox reference. Additionally, as discussed above, the disclosure of the cited references are not sufficient to render the claims *prima facie* obvious.

Furthermore, “[a] rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective

functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.” (MPEP § 2143.02, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950), emphasis added).

As discussed above within the previous sections, the Patent Office has failed to identify all of Appellant’s claimed elements within the cited combination of references. The Patent Office has further failed to provide articulated reasoning that does not require a change in the respective function of the Wilcox reference.

Accordingly, for at least these additional reasons the present rejections should be overturned.

3. The Wilcox Reference Teaches Away from the Subject Matter of Claim 104

The third reason that the obviousness rejection is deficient is that the Wilcox reference actually teaches away from Appellant’s claimed subject matter. As discussed above, a reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (MPEP § 2141.02 VI citing *W.L. Goré & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), emphasis in original).

The Wilcox reference discloses that one type of node is a category item 112 that includes a list of category item icon nodes 120. (Wilcox, Figures 15, 16, and 18, as cited by the Patent Office; See also, Figures 5, 6, and 7). The Wilcox reference discloses that another type of node is a menu item 114 that includes a list of menu item icon nodes 122. (Wilcox, Figures 15, 16, and 18, as cited by the Patent Office; See also, Figures 5, 6, and 7). As such, the Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 are separated within the respective category item 112 and the menu item 114. Accordingly, the Wilcox reference discloses that the category item 112 that includes a list of category item icon nodes 120 is distinct from the menu item 114 that includes a list of menu item icon nodes 122.

Stationary visual cues 124 inform the viewer that the category item icon nodes 120 may be scrolled left and right. (Wilcox, Figures 5, 6; and col. 20, lines 30-32). Stationary visual cues

130 inform the viewer that the menu item icon nodes 122 may be scrolled up and down. (Wilcox, Figures 5, 6; and col. 22, lines 2-4). As such, the Wilcox reference discloses that the category item icon nodes 120 and the menu item icon nodes 122 are separated by “stationary” visual cues, 124 and 130, respectively, and that these nodes have “stationary” visual cues 124 and 130, respectively, at the ends of the respective nodes.

The Wilcox reference further discloses that the category item icon nodes 120 and the menu item icon nodes 122 may be placed in various locations on a television display device. (Wilcox, column 23, lines 15-17). As such, the Wilcox reference obviates the need to allow multiple lists to intersect at least by allowing a user the flexibility to move the respective lists independently of one another.

Based upon these several distinctions and disclosures of the Wilcox reference, the Wilcox reference teaches away at least from Appellant’s claimed “the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location”

Accordingly, for at least these additional reasons the present rejections should be overturned.

4. The Knowles Reference Teaches Away from the Subject Matter of Claim 104

The fourth reason that the obviousness rejection is deficient is that the Knowles reference actually teaches away from Appellant’s claimed subject matter. As discussed above, a reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (MPEP § 2141.02 VI citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), emphasis in original).

The Knowles reference discloses a requirement for either a timeout period or for the user to select a SELECT key on a remote device to perform the disclosed actions. For example, the Knowles reference discloses that “[w]hen the pop-up times out (in two seconds) or the user presses SELECT, the IPG closes the guide and tunes to the new channel.” (Knowles, column 15, lines 13-15, as cited by the Patent Office).

As such, the Knowles reference requires either a timeout to expire or requires a user interaction with a specific button (e.g., the SELECT button) to tune to a new channel. Appellant

respectfully submits that an “either/or” combination of functionality within the cited portion of the Knowles reference does not teach or suggest at least Appellant’s claimed “unless” conditional.

Based upon this disclosure, the Knowles reference appears to teach away from Appellant’s claimed subject matter by requiring additional actions to occur prior to tuning to a new channel. By the Knowles reference requiring a delay for the timeout to expire or the user to further interact and depress the specific SELECT key on a remote device for a new channel to actually be tuned, the Knowles reference teaches away from Appellant’s claimed subject matter.

Accordingly, for at least these additional reasons the present rejections should be overturned.

**5. The Patent Office Has Engaged in Impermissible Hindsight Reconstruction
and Has Used Appellant’s Specification as a Template to Form the Rejection
of Claim 104**

The fifth reason that the obviousness rejection is deficient is that the Patent Office’s rejections rely upon Appellant’s present application to fill the gaps in the cited references. The Patent Office has not articulated any reasoning as to why a person of ordinary skill in the art would find the claims obvious in view of the missing elements discussed above. Accordingly, the Patent Office has engaged in impermissible hindsight reconstruction and has used Appellant’s application to form the rejections of the claims.

It is impermissible to pick and choose elements from the prior art while using the application as a template. *In re Fine*, 837 F.3d 1071 (Fed. Cir. 1988). To reconstruct the invention by such selective extraction constitutes impermissible hindsight. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991).

Appellant has identified many elements above that are missing from the cited references. As such, it is untenable for the present rejections to stand without the aid of impermissible hindsight reconstruction. The Patent Office has further not articulated any reasoning as to why a person of ordinary skill in the art would find the claims obvious in view of the missing elements discussed above.

Accordingly, for at least this additional reason the present rejections should be overturned.

E. Conclusion

As discussed above, the allegations of the Patent Office regarding the actual disclosure of the cited references constitute material and clear errors of fact regarding the scope and content of the cited references. As such, the Patent Office has not identified all elements of Appellant's claim 104 within the cited combination of references. The Patent Office has cited references that are not of record in the present matter.

Based at least upon the clear errors of fact regarding the scope and content of the cited references, the allegations of the Patent Office constitute material and clear errors of fact regarding the differences between Appellant's claim language and the disclosure of the cited references. Further, the Patent Office has failed to properly consider Appellant's claim language and has alleged additional material and clear factual errors regarding differences between Appellant's claim language and the disclosure of the cited references.

The Wilcox reference teaches away from Appellant's claimed subject matter and cannot be modified and combined with the cited references without rendering the Wilcox reference unsatisfactory for its intended purpose and without changing at least one of its principles of operation. The Knowles reference also teaches away from Appellant's claimed subject matter.

Furthermore, based at least upon the many gaps between the actual disclosure of the cited references and Appellant's claims, the Patent Office has engaged in impermissible hindsight reconstruction and has not articulated any reasoning as to why a person of ordinary skill in the art would find the claims obvious in view of the missing elements discussed above.

The Patent Office has ignored certain portions of Appellant's claim language, has failed to properly analyze the subject matter of the cited references, and has failed to properly determine the differences between Appellant's claimed subject matter and the references as cited. For these and other reasons, the Patent Office's allegations of fact are clearly erroneous.

Further, the Patent Office's interpretation of the Wilcox reference in combination with the Gospel and Knowles references is at least clearly erroneous and is not reasonable to someone skilled in the art. The clearly erroneous interpretations of the cited references further shows that the Patent Office has failed to properly consider the language of Appellant's claims, has failed to properly consider the actual disclosure of the cited references, and has failed to properly consider the differences between the claims and the cited references – all clear errors of fact.

For at least these reasons, the Patent Office's legal conclusion of obviousness is also deficient as at least failing to properly consider the actual scope and contents of the cited references, and for failing to properly consider the differences between the claimed subject matter and the actual disclosure of the cited references. Accordingly, the Patent Office has failed to establish a *prima facie* case of obviousness against claim 104 for at least these additional reasons.

Accordingly, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

Respectfully submitted,

/Jerry A. Miller 30779/

Jerry A. Miller
Registration No. 30,779

Dated: 8/6/2009

Please Send Correspondence to:
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337

8. CLAIMS APPENDIX

1-86. (Cancelled Without Prejudice)

87-103. (Withdrawn)

104. (Previously Presented) In an audio/visual (AV) system, a method for navigation of menu options available to a user of the AV system, comprising:

entering a graphical user interface (GUI) in a menu system that is displayed on a display;

generating a signal for displaying a first navigable list of menu options on the display, the first navigable list of menu options having a plurality of fields arranged in a first linear configuration that overlays AV content currently playing on the display with one of the menu options shown at a location of the display that is highlighted;

responsive to a navigation command from a remote controller, moving the first navigable list of menu options of the GUI to cause another field of the plurality of fields to move to the location that is highlighted, and thus highlight the another field while continuing to display the AV content currently playing on the display;

responsive to a navigation command from the remote controller, generating a signal for displaying a second navigable list of menu options associated with the highlighted field, the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location and overlaying the AV content currently playing on the display;

navigating to a menu option of the second navigable list of menu options in response to a navigation command;

selecting the menu option of the second navigable list in response to a selection command from the remote controller, wherein the AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content;

upon selection of the menu option from the second navigable list, ceasing the generating of the signals for displaying the first and second navigable list of menu options so that the first

and second navigable list of menu options disappear from the display and taking an action associated with the menu selection; and

wherein the first linear configuration of the first menu is oriented substantially horizontally, and the second linear configuration of the second menu is oriented substantially vertically.

9. EVIDENCE APPENDIX

Appellant relies on no evidence, thus this appendix is not applicable.

10. RELATED PROCEEDINGS APPENDIX

There are no related proceedings, thus this appendix is not applicable.